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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,870	01/30/2004	Yoko Hirotsugi	00862.023427.	4094
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EXAMINER UHLENHAKE, JASON S				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/766,870

**Applicant(s)**

HIROSUGI ET AL.

**Examiner**

JASON S. UHLENHAK

**Art Unit**

2853

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 66-74 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 66-74 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

Claim 66 is objected to because of the following informalities: Appears to be a error in the claim language, "pervious", line 2 of the fourth paragraph. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 72 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The sixth paragraph of claim 72 discloses "a warning unit, configured to warn when it is determined by the first determination unit that the present user is the same as the previous user and it is determined by the second determination unit that the present print setting is not the same as the previous print setting" is not found in the specification filed 1/30/2004. The specification discloses issuing a warning when the present user and the previous user are not the same and the present print setting is not the same as the previous print setting. However the specification discloses if it is found that the same user is continuing to utilize the printer,

then it is judged that the printer settings need not be changed and not alert relating to settings is issued (page 29) and does not disclose issuing a warning when the present and previous users are the same (pages 26-29).

Claim 73 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The sixth paragraph of claim 73 discloses "a warning step of warning when it is determined in the first determining step that he present user is the same as the previous user and it is determined in said second determining step that he present print setting is not the same as the previous sprint setting" is not found in the specification filed 1/30/2004. The specification discloses issuing a warning when the present user and the previous user are not the same and the present print setting is not the same as the previous print setting. However the specification discloses if it is found that the same user is continuing to utilize the printer, then it is judged that the printer settings need not be changed and not alert relating to settings is issued (page 29) and does not disclose issuing a warning when the present and previous users are the same (pages 26-29).

Claim 74 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which

was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The sixth paragraph of claim 74 discloses "a warning step of warning when it is determined in the first determining step that the present user is the same as the previous user and it is determined in said second determining step that the present print setting is not the same as the previous print setting" is not found in the specification filed 1/30/2004. The specification discloses issuing a warning when the present user and the previous user are not the same and the present print setting is not the same as the previous print setting. However the specification discloses if it is found that the same user is continuing to utilize the printer, then it is judged that the printer settings need not be changed and not alert relating to settings is issued (page 29) and does not disclose issuing a warning when the present and previous users are the same (pages 26-29).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 66-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujimoto et al (U.S. Pat. 6,950,613) in view of Yoshida (U.S. Pub. 2002/0018226) and Miyazaki et al (U.S. Pat. 6,832,010)

***Fujimoto discloses:***

- ***regarding claim 66***, an information processing apparatus connected with a printer via an interface, wherein the printer has no sensor for sensing a print setting, receives print data and an ID of a printer driver sent from the information processing apparatus, and has a storage unit for storing print settings contained in the received print data (Column 31, Lines 9-33; Column 31, Line 62 – Column 32, Lines 15)

The structure of the printer does not limit the claims since the claims are directed to an information processing apparatus

- the information processing apparatus comprising: a first obtaining unit, configured to obtain from the storage unit of the printer an ID that has given the printer a print instruction at a previous time;

- a first unit, configured to determine whether or not the ID obtained from the storage unit and the ID that has given the printer a print instruction at a present time to provide information whether or not a present user who gives a print instruction to a printer at the present time is the same as the previous user at the previous time (Column 31, Lines 20-32). It is obvious to determine a user or when a user has changed from the IC card, user log-in, or a driver which stores information of the user, for the purpose of recognizing operational errors as disclosed by Fujimoto.

- a second obtaining unit, configured to obtain a previous setting used by the present user at a previous time from the storage unit of the printer (Column 31, Line 61 – Column 32, Line 15)

- a second determination unit, configured to determine print settings (Column 31, Lines 62 - Column 32, Line 9) (operating conditions of the office information systems)

- a warning unit, configured to warn when it is determined by the second determination unit that the present print setting is not the same as the previous print setting (Column 32, Lines 4-14); and a transmission unit, configured to transmit print data to the printer either when it is determined by the second determination unit that the present print setting is the same as the previous print setting or when it is determined by the first determination unit that the present user is the same as the previous user (Column 31, Line 62 – Column 32, Line 22)

- **regarding claim 67**, and obtaining unit configured to obtain a ID that gave a print instruction from the printer; wherein the first determination unit determines whether or not a present user who gives a print instruction to a printer at the present time is the same as the previous user at the previous time by determining whether or not the ID obtained by the obtaining unit is the same as the ID that gives a print instruction to the printer at the present time (Column 31, Line 62 – Column 32, Line 22)

- **regarding claim 68**, an information processing method, comprising: a first obtaining step of obtaining from a storage unit a printer ID that has given the printer a print instruction at a previous time

- a first step of providing information whether or not the ID obtained from the storage unit and the ID that has given the printer a print instruction at a present time of determining whether or not a preset user who gives a print instruction to a printer at the

present time is the same as the previous user at the previous time (Column 31, Lines 20-32). It is obvious to determine a user or when a user has changed from the IC card, user log-in, or a driver which stores information of the user, for the purpose of recognizing operational errors as disclosed by Fujimoto.

- a second obtaining step, to obtain a previous setting used by the present user at a previous time from the storage unit of the printer (Column 31, Line 61 – Column 32, Line 15)

- a second determination step to determine print settings (Column 31, Lines 62 - Column 32, Line 9) (operating conditions of the office information systems)

- a warning step of warning when it is determined by the second determination step that the present print setting is not the same as the previous print setting (Column 32, Lines 4-14); and a transmission step to transmit print data to the printer either when it is determined by the second determination step that the present print setting is the same as the previous print setting or when it is determined by the first determination unit that the present user is the same as the previous user (Column 31, Line 62 – Column 32, Line 22)

- ***regarding claim 69, 71***, and obtaining step to obtain a ID that gave a print instruction from the printer; wherein the first determination step determines whether or not a present user who gives a print instruction to a printer at the present time is the same as the previous user at the previous time by determining whether or not the ID obtained by the obtaining step is the same as the ID that gives a print instruction to the printer at the present time (Column 31, Line 62 – Column 32, Line 22)

- **regarding claim 70**, a computer-readable medium in which a computer-executable program is stored for making a computer perform and information processing method, the method comprising:

- a first step of providing information whether or not a present user who gives a print instruction to a printer at the present time is the same as the previous user at a previous time (Column 31, Lines 20-32). It is obvious to determine a user or when a user has changed from the IC card, user log-in, or a driver which stores information of the user, for the purpose of recognizing operational errors as disclosed by Fujimoto.

- a second determination step to determine print settings (Column 31, Lines 62 - Column 32, Line 9) (operating conditions of the office information systems)

- a warning step of warning when it is determined by the second determination step that the present print setting is not the same as the previous print setting (Column 32, Lines 4-14);

- and a transmission step to transmit print data to the printer either when it is determined by the second determination step that the present print setting is the same as the previous print setting or when it is determined by the first determination unit that the present user is the same as the previous user (Column 31, Line 62 – Column 32, Line 22)

***Fujimoto does not expressly disclose:***

- **regarding claim 66**, a second obtaining unit, configured to obtain a previous setting used by the present user at a previous time from the storage unit of the printer when it is determined by the first determination unit that the present user is not

the same as the previous user; determining whether or not a present print setting set at the present time is the same as the previous print setting obtained from the storage unit of the printer by the second obtaining unit

- **further regarding claims 66-69, 71**, obtaining a printer driver ID of a printer drive
- **regarding claim 68**, a second obtaining step to obtain a previous setting used by the present user at a previous time from the storage unit of the printer when it is determined by the first determination step that the present user is not the same as the previous user; determining step of whether or not a present print setting set at the present time is the same as the previous print setting obtained from the storage unit of the printer by the second obtaining step
- **regarding claim 70**, a second obtaining step to obtain a previous setting used by the present user at a previous time from the storage unit of the printer when it is determined by the first determination step that the present user is not the same as the previous user; determining step of whether or not a present print setting set at the present time is the same as the previous print setting obtained from the storage unit of the printer by the second obtaining step

***Yoshida discloses:***

- **regarding claim 66**, a second obtaining unit, configured to obtain a previous setting used by the present user at a previous time from the storage unit of the printer when it is determined by the first determination unit that the present user is not the same as the previous user; determining whether or not a present print setting set at

the present time is the same as the previous print setting obtained from the storage unit of the printer by the second obtaining unit (Paragraphs 0050-0051)

- **regarding claim 68**, a second obtaining step to obtain a previous setting used by the present user at a previous time from the storage unit of the printer when it is determined by the first determination step that the present user is not the same as the previous user; determining step of whether or not a present print setting set at the present time is the same as the previous print setting obtained from the storage unit of the printer by the second obtaining step (Paragraphs 0050-0051)

- **regarding claim 70**, a second obtaining step to obtain a previous setting used by the present user at a previous time from the storage unit of the printer when it is determined by the first determination step that the present user is not the same as the previous user; determining step of whether or not a present print setting set at the present time is the same as the previous print setting obtained from the storage unit of the printer by the second obtaining step (Paragraphs 0050-0051)

Yoshida discloses that multiple users may use different types of paper in the printing apparatus and instructing the user to the desired sheet in the paper supply port. Fujimoto discloses determining a user and outputting the operating conditions prior to printing, therefore the combination would be to inform the user that the settings (print medium type) are not correct when a plurality of users are using the same printing apparatus. Yoshida further discloses that it is necessary to determine if a current user is different from the previous user for the purpose of performing the print job as desired by the user.

***Miyazaki discloses:***

- ***regarding claim 66-69, 71***, obtaining a printer driver ID of a printer drive (Figure 3; Column 4, Line 62 – Column 5, Line 4), for the purpose of identifying or displaying which user sent the print job to the main controller of the apparatus

At the time the invention was made it would have been obvious to a person of ordinary skill in the art to incorporate the teaching of Yoshida and Miyazaki into the device of Fujimoto, for the purpose of performing the print job as desired by the user and identifying or displaying which user sent the print job to the main controller of the apparatus.

***Response to Arguments***

Applicant's arguments with respect to claims 66-74 have been considered but are moot in view of the new ground(s) of rejection. The combination of Fujimoto et al (U.S. Pat. 6,950,613) in view of Yoshida (U.S. Pub. 2002/0018226) and Miyazaki et al (U.S. Pat. 6,832,010) discloses an information processing apparatus determining if the present user is the same as the previous user, determining if the present and previous print settings are the same, and issuing a warning to the user under the correct circumstances. At the time of the invention it would be obvious to a person of ordinary skill in the art to use the combination of Fujimoto in view of Yoshida and Miyazaki for the purpose of performing the print job as desired by the user and identifying or displaying which user sent the print job to the main controller of the apparatus. Please see the rejection above.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **JASON S. UHLENHAK** whose telephone number is (571)272-5916. The examiner can normally be reached on **Monday-Friday 8:00-5:00**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JASON S UHLENHAKE/  
Examiner, Art Unit 2853  
May 8, 2009

/Julian D. Huffman/  
Primary Examiner, Art Unit 2853